



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/585,635	07/11/2006	Anna Quattropani	293065US0PCT	8529
22850	7590	10/23/2009	EXAMINER	
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314				STOCKTON, LAURA LYNNE
ART UNIT		PAPER NUMBER		
1626				
NOTIFICATION DATE			DELIVERY MODE	
10/23/2009			ELECTRONIC	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary	Application No.	Applicant(s)
	10/585,635	QUATTROPANI ET AL.
	Examiner	Art Unit
	Laura L. Stockton	1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 15 July 2009.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-26 is/are pending in the application.
 4a) Of the above claim(s) 18-25 is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-17 and 26 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date See Continuation Sheet.

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
 5) Notice of Informal Patent Application
 6) Other: _____.

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :October 11, 2006 and November 24, 2006.

DETAILED ACTION

Claims 1-26 are pending in the application.

Election/Restrictions

Applicant's election with traverse of Group I (claims 1-17 and 26 – drawn to products of formula (I) wherein X is S) in the reply filed on July 15, 2009 is acknowledged. **Note:** Claim 26 is a pharmaceutical composition claim and should be grouped with the product claims and not the method of use claims as found in the Restriction Requirement of June 15, 2009.

The traversal is on the ground(s) that: (1) no adequate and/or examples have been provided to support a conclusion of patentable distinctiveness between the identified groups; (2) no burden has been shown to exist, as required by M.P.E.P. § 803, in searching the claims of the four groups; and (3) should Group I be

found allowable, the search should be expanded to the inventions of Groups II, III and IV.

This is not found persuasive because the inventions outlined in the Lack of Unity dated June 15, 2009 are properly restrictable. Applicant argues that no adequate and/or examples have been provided to support a conclusion of patentable distinctiveness between the identified groups. In response, the products of Group I and Group II are distinct since the products in each group differ materially in structure and element so much so as to be patentably distinct. In addition, a reference that anticipates one group may not even render obvious the other. Note the compound in CA 75:35865 to Suciu.

Applicant argues that no burden has been shown to exist, as required by M.P.E.P. § 803, in searching the claims of the four groups. In response, the instant application is a 371 application and as such, a lack of unity under PCT Rule 13.1 and 13.2 has been established

between the claimed inventions of Groups I-IV. It was shown in the lack of unity that the special technical feature, which is a thiazole ring attached to a 5-membered nitrogen containing ring, does not define a contribution over the prior art. Additionally, the search for only the invention of elected Group I recovered over 900 registry numbers in one database search alone. Therefore, Applicant's argument is not persuasive.

Applicant argues that should Group I be found allowable, the search should be expanded to the inventions of Groups II, III and IV. In response, if the products of elected Group I are ever in condition for allowance, only the methods of use of Group III would be in consideration for rejoinder and only if the scope of Group III at that the time the products are found allowable has the same scope of the allowable products of Group I and if the prosecution is still open. However, the elected products of Group I are not

allowable at this time (see below rejections) and therefore, rejoinder is not applicable at this time.

The requirement is still deemed proper and is therefore made FINAL.

Subject matter not embraced by elected Group I and Claims 18-25 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on July 15, 2009.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

The Examiner has considered the Information Disclosure Statements filed on October 11, 2006 and November 24, 2006.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the various variables in Formula (I) (i.e., X, R¹, R², R³, etc.) found in instant claim 1 have not defined in the instant specification. Note page 9 of the instant specification, lines 1-5.

Claim Objections

Claim 6 is objected to because of the following informalities: in claim 6, the "and" before "C₃-C₈-

cycloalkyl C₁-C₆-alkyl" should be deleted. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-13, 15 and 26 are rejected under 35

U.S.C. 102(b) as being clearly anticipated by:

a) CA Registry No. 421580-67-8 {entry date in the Registry file on STN May 24, 2002};

- b) CA Registry No. 421580-64-5 {entry date in the Registry file on STN May 24, 2002};
- c) CA Registry No. 421580-59-8 {entry date in the Registry file on STN May 24, 2002};
- d) CA Registry No. 421580-54-3 {entry date in the Registry file on STN May 24, 2002};
- e) CA Registry No. 421580-52-1 {entry date in the Registry file on STN May 24, 2002};
- f) CA Registry No. 412919-68-7 {entry date in the Registry file on STN May 9, 2002};
- g) CA Registry No. 315705-85-2 {entry date in the Registry file on STN January 22, 2001};
- h) CA Registry No. 315704-55-3 {entry date in the Registry file on STN January 22, 2001};
- i) Inaba et al. {JP 2002/53566 A} - see, for example, Compounds 5 and 6 on page 40 of 48 in the provided English translation;
- j) CA Registry No. 412919-72-3 {entry date in the Registry file on STN May 9, 2002}; or

k) Suciu et al. {CA 75:35865, 1971} - see the compound of CA Registry No. 32519-86-1.

Each of the above cited prior art disclose at least one compound that is embraced by the instant claimed invention. Therefore, each of the above cited prior art anticipate the instant claimed invention.

Claims 1, 3-5, 8, 9, 13 and 26 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Wu et al. {WO 2006/050351 A2}.

Wu et al. disclose, for example, Compound Number 1 in Table 1 on page 18 which is embraced by the instant claimed invention. Therefore, Wu et al. anticipate the instant claimed invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-17 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inaba et al. {JP 2002/53566 A}, Wu et al. {WO 2006/050351 A2} and Takaya et al. {U.S. Pat. 4,649,146}, each taken alone. An English translation has been provided of the JP document and will be referred to hereinafter.

Determination of the scope and content of the prior art (MPEP §2141.01)

Applicant claims thiazole compounds. **Inaba et al.** (see entire document; particularly page 11 of 48 thru page 16 of 48, page 25 of 48 thru page 26 of 48; and especially Compounds 5 and 6 on page 40 of 48), **Wu et**

al. (see entire document; particularly pages 4, 5, 7 and 10-12; and especially Compound Number 1 in Table 1 on page 18) and **Takaya et al.** (see entire document; particularly column 1; formula [Ik] at the top of column 5, lines 1-5; column 11, lines 28-33; column 12, lines 41-45; and especially Examples 85 and 87 in column 46 and Compound 123 in column 55) each teach thiazole compounds that are either structurally the same as (see above 102 rejection) or structurally similar to the instant claimed compounds.

Ascertainment of the difference between the prior art and the claims
(MPEP §2141.02)

The difference between some of the compounds of the prior art and the compounds instantly claimed is that the instant claimed compounds are generically described in the prior art.

Finding of prima facie obviousness--rational and motivation (MPEP §2142-2413)

The indiscriminate selection of "some" among "many" is *prima facie* obvious, In re Lemin, 141 USPQ 814

(C.C.P.A. 1964). The motivation to make the claimed compounds derives from the expectation that structurally similar compounds would possess similar activity (e.g., protein kinase Cy inhibitors).

One skilled in the art would thus be motivated to prepare products embraced by the prior art to arrive at the instant claimed products with the expectation of obtaining additional beneficial products which would be useful as, for example, a pain killer. The instant claimed invention would have been suggested to one skilled in the art and therefore, the instant claimed invention would have been obvious to one skilled in the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (571) 272-0710. The examiner can normally be reached on Monday-Friday from 6:00 am to 2:30 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (571) 272-0699.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

The Official fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

/Laura L. Stockton/
Laura L. Stockton
Primary Examiner, Art Unit 1626
Work Group 1620
Technology Center 1600

October 21, 2009